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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL NELSON, PETER WILLIAMS,
and JENNIFER KRONE

Appeal 2007-3937
Application 09/808,314
Technology Center 1600

Decided: August 6, 2008

Before DEMETRA J. MILLS, ERIC GRIMES, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellants request rehearing under 37 C.F.R. § 41.52 of our Decision entered Jan. 24, 2008 (“Dec.”) in which we affirmed the Examiner’s final rejection of claims 31-33, 35-40, 42, 44-46, and 48 over prior art.

ISSUES

The following issues are raised by Appellants in their Request for Rehearing:

1. Whether we erred in finding that Papac and Gaskell disclose every element of claim 31 (Req. Reh'g 3).
2. Whether we erred in concluding that the claimed invention, particularly claims 35 and 36, would have been obvious to persons of ordinary skill in the art in view of the teachings of Papac and Gaskell (*id.*).

Issue 1

In finding claims 31-33, 35, and 36 obvious over Papac in view of Gaskell (Dec. 4), we made the following findings about the differences between the prior art and claim 31:

15. Papac does not describe “c. quantifying” the analyte “using only single dimension mass spectrometric analysis to resolve distinct signals for the analyte and said IRS to determine the amount of the captured analytes relative to the IRS” as recited in claim 31.
(Dec. 6.)
17. Gaskell also describes quantifying the amount of analyte using the signals from the analyte and the internal standard in mass spectroscopy (FF 11-12; Gaskell, at pp. 459-60; Answer 5), but not “using only a single dimension mass spectrometric analysis” as recited in step c. of claim 31.
(*id.* at 7.)

Citing these findings, Appellants state:

Accordingly, the Board has determined that neither the Papac reference nor the Gaskell reference discloses Appellant's claimed element of using only single dimension mass spectrometric analysis for quantifying the one or more analytes.

Therefore, in that neither Papac or Gaskell disclose each and every element of Appellant's claimed invention, it could not have been obvious to one of ordinary skill in the art to combine Papac and Gaskell to arrive at Appellant's claims.

(Req. Reh'g 3.)

This argument is not persuasive. Finding of Fact 15¹ (*supra*) explicitly acknowledges that Papac does not describe quantifying an analyte in a single dimension as required by claim 31. However, quantifying an analyte had been accomplished by Gaskell in mass spectroscopy, just not in a single dimension (*see* FF17). Findings of Fact 18 through 23 provide a rationale as to why persons of ordinary skill in the art would have been prompted to modify Papac's method with Gaskell's teaching to quantify an analyte in a mass spectroscopic method, including in single dimension mass spectroscopic analysis. Thus, based on the combined teachings, we found that all the elements of the claimed method were disclosed or suggested by the prior art, i.e., "using only single dimension mass spectrometric analysis for quantifying the one or more analytes" (Req. Reh'g 3; FF15).

If Appellants mean to imply that "single dimension mass spectrometric analysis" as recited in claim 31 is not described in Papac or Gaskell, we note that such argument was not made in the Appeal or Reply Brief.² Under 37 C.F.R. § 41.52(a)(1), new arguments are not permitted in a request for rehearing unless certain exceptions are met. *See* 37 C.F.R. § 41.52(a)(2)-(3). Since Appellants have not argued that either of

¹ The Findings of Fact ("FF") refer to the findings in our original Decision.

² On page 4 of the Answer, the Examiner made the finding that Papac discloses MALDI/TOF mass spectroscopy which is single dimension mass spectrometric analysis. It does not appear that Appellants challenged this finding in their Appeal or Reply Briefs.

the exceptions allowing a new argument has been met, we decline to revisit our earlier conclusion.

Issue 2

Appellants assert that “if one were to use an internal reference standard in the method disclosed by Papac, one would still not arrive at Appellant’s claimed invention, and in particular Appellant’s claims 35 and 36” (Req. Reh’g 3).

Our decision articulated a reason why persons of ordinary skill in the art would have been prompted to combine the prior art to arrive at the subject matter of claim 31. *See* FF18-23. In asserting that the “one would still not arrive at Appellant’s claimed invention” (Req. Reh’g 3), Appellants do not “state with particularity the points believed to have been misapprehended or overlooked by the Board,” as required by 37 C.F.R. § 41.52(a). Since Appellants have not identified any points that we overlooked or misunderstood, we decline to revisit or modify our earlier conclusion.

Appellants also assert that the prior art does not suggest the subject matter of claims 35 and 36 (Req. Reh’g 3-5). However, these are new arguments. Appellants did not previously address the specific limitations in claims 35 and 36 which are now argued. They refer to page 12 of their Appeal Brief for “previously distinguish[ing] the Papac reference from Appellant’s claims 35 and 36” (Req. Reh’g 5), but this page makes no reference to claims 35 and 36 nor to the “dissociation agent” recited in them. Appellants state in the Request for Rehearing that “Papac fails to disclose releasing an isolated analyte species from an antibody” and then detecting it

(*id.*), but our Decision specifically addressed this issue by identifying disclosure of isolated analyte in Gaskell (FF9-10) as required by claim 31 (FF13).

Under § 41.52(a), “[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing.” Appellants’ arguments concerning claims 35 and 36 were not previously raised in the Appeal and Reply Briefs and therefore are not a proper basis for a Request for Rehearing.

CONCLUSION

We have considered Appellants’ Request for Rehearing, but decline to modify our original Decision entered Jan. 24, 2008.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING DENIED

dm

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